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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/676,861

09/30/2003

Tatsuki Wade

SANKY P-242 /
500615.2020

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26418

7590

03/13/2006

EXAMINER

WATKO, JULIE ANNE

REED SMITH, LLP

ATTN: PATENT RECORDS DEPARTMENT

599 LEXINGTON AVENUE, 29TH FLOOR

NEW YORK, NY 10022-7650

ART UNIT

PAPER NUMBER

2653

DATE MAILED: 03/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/676,861

Applicant(s)

WADE, TATSUKI

Examiner

Julie Anne Watko

Art Unit

2653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
2. Applicant cannot rely upon the foreign priority papers to overcome any rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Drawings

3. Figures 5A-6B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

4. The substitute specification filed February 17, 2004, has been entered.
5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horita et al (US PAP No. 2002/0141323 A1).

As recited in claim 1, Horita et al show an optical head device 10 comprising: a lens holder 14 in which an objective lens 12 and drive coils (including 16 and 18) are mounted; a plurality of elastic support members 26a-d which support said lens holder to move in a focusing direction and a tracking direction; said lens holder 14 having a coil holding portion 14b for holding said drive coils and a lens holding portion 14a which projects from said coil holding portion to the front to hold said objective lens; and said lens holding portion 14a being formed thinner (see Fig. 3) than said coil holding portion 14b to avoid interference with a deflecting element 60 positioned beneath said lens holding portion, having a flat surface, and having first vibration-absorbing member attached to the front end portion thereof.

As recited in claim 1, Horita et al are silent regarding an arc shape from the side portion to the front along the outer circumference of said objective lens.

There is no invention in changing the shape of a known apparatus, absent unexpected results due to the claimed shape, provided that the claimed shape is within the level of ordinary skill in the art. In re Dailey, 357 F.2d 669, 149 USPQ 47 (CCPA 1966).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to arrive at the claimed shape as is notoriously well known in the art. The rationale is as follows: one of ordinary skill in the art would have been motivated to provide an arc shape so

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as to avoid sharp edges that could injure a worker during assembly as is notoriously well known in the art.

As recited in claim 2, in addition to the above teachings, Horita et al are silent regarding whether at least one second vibration-absorbing member being provided at the border between said coil holding portion and said lens holding portion.

Mere duplication of parts has no patentable significance unless a new and unexpected result is produced. In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960). Furthermore, there is no invention in changing the location of a known part, when the functioning of the apparatus is not changed by the relocation. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a second vibration-absorbing member in the claimed location. The rationale is as follows: one of ordinary skill in the art would have been motivated to add a second vibration-absorbing member in the claimed location in order to increase a vibration-absorbing effect as is notoriously well known in the art.

8. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Horita et al (US PAP No. 2002/0141323 A1) as applied to claims 1 and 3 above, and further in view of Naraoka et al (JP 2005-538062).

Horita et al show a head as described above for claims 1-2.

As recited in claim 3, Horita et al are silent regarding an arc shape from the side portion to the front along the outer circumference of said objective lens.

See teachings, rationale and motivation stated above for claim 1.

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As recited in claim 3, Horita et al are silent regarding a first shock-absorbing member attached to the front end portion thereof.

As recited in claim 3, Naraoka et al teach the addition of shock-absorbing members to a head in order to increase reliability.

Furthermore, there is no invention in changing the location of a known part, when the functioning of the apparatus is not changed by the relocation. In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add a shock-absorbing member to the claimed location. The rationale is as follows: one of ordinary skill in the art would have been motivated to improve apparatus reliability as taught by Naraoka et al and as is notoriously well known in the art.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kudou et al (JP 10-079128 A) show an objective lens actuator with collision damper unit 10 provided to protrude in parallel along a focusing direction.

Nagata (JP 2000-348358 A) shows an optical pickup comprising weight material 12 to prevent unnecessary resonance of a movable part containing the objective lens.

Kamata et al (JP 3-144924 A) show an objective lens driving device for optical pickup comprising balancer 4-1 and both-face adhesive tape 7 to relieve or eliminate high-order resonance.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julie Anne Watko whose telephone number is (571) 272-7597. The examiner can normally be reached on T11A-5P W3P-9P Th11:30A-10P F10A-8:30P SatNoon-8:30P.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Julie Anne Watko
Primary Examiner
Art Unit 2653

March 6, 2006
JAW

A handwritten signature in black ink, appearing to read 'Julie Anne Watko', with a stylized flourish at the end.